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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,700	07/03/2001	Manfred Jost	22750/487	2445
26646	7590	11/25/2003		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER	BOYD, JENNIFER A
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/898,700	JOST ET AL.
	Examiner Jennifer A Boyd	Art Unit 1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 September 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 pages.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of claims 1 - 9 in the Response filed September 3, 2003 is acknowledged. The traversal is on the ground(s) that the two groups of claims are not independent and the search of Group I would encompass the search of Group II. This is not found persuasive because the claims are both independent and distinct. Although, claims 10 - 14 depend from claim 1, there is nothing in the limitations of claim 1 that would be a direct result of applying the resin by means of a scatter-coating process, a hot melt application, a lamination process or spinning process. Therefore, an alternate method such as a paste-dot coating process could be used to create the water-soluble fusible embroidery liner. Additionally, the search of Group I would involve a search in class 442 while a search for Group II would involve a search in class 156, so searching Group II would be burdensome to the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 - 2, 4 - 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamura et al. (US 4,570,311).

Kawamura et al. is directed to a method for preparing water soluble fabric for chemical

laces (Abstract).

As to claim 1, Kawamura teaches a hot water soluble polyvinyl alcohol web formed by carding or air-laying (column 2, lines 35 – 40) sprayed with an aqueous solution of water soluble resin (column 2, lines 45 – 50). The Examiner equates the hot water soluble polyvinyl alcohol web to Applicant's "water-soluble nonwoven fabric". Kawamura teaches in the example that the web can have a weight per unit area of 50 g/m<sup>2</sup> (column 3, lines 47 – 50). Kawamura teaches that the water soluble resin can include polyvinyl alcohol (column 3, lines 26 – 30). The Examiner equates the water-soluble resin to Applicant's "adhesive mass".

As to claim 2, Kawamura teaches that the water-soluble resin can comprise polyvinyl alcohol (column 3, lines 26 – 30) and notes that the resin used for the fibers in the web can also be used as the water soluble resin (column 3, lines 30 – 35). Kawamura teaches that the polyvinyl alcohol fibers, and therefore resin, can be saponified with alkali (column 2, lines 25 – 35). The Examiner equates the saponification of the polyvinyl alcohol fibers to Applicant's "modification of polyvinyl alcohol".

As to claim 4, Kawamura teaches that the web, or "water-soluble nonwoven fabric", is a hot water soluble polyvinyl alcohol web formed by carding or air-laying (column 2, lines 35 – 40).

As to claims 5 – 6 and 8, Kawamura teaches that the polyvinyl alcohol fibers and resin after saponification is readily soluble in water at temperatures of about 40 to 90 degrees Celsius (column 2, lines 25 – 35).

4. Claims 1 – 3 and 5 - 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al. (EP 0896089A1).

As to claim 1, Takeuchi is directed to a water-disintegratable fibrous sheet (Title). Takeuchi teaches a fibrous sheet coated with a water-soluble binder of polyvinyl alcohol (Abstract). Takeuchi teaches that the fibrous sheet has good dispersibility in water (page 3, [0018]). The Examiner equates the fibrous sheet to Applicant's "water-soluble nonwoven fabric" and the water-soluble binder to Applicant's "adhesive mass". In Example 1, Takeuchi teaches that the fibrous base sheet has a basis weight of 50 g/m<sup>2</sup> (page 4, [0034]).

As to claim 2, Takeuchi teaches that the polyvinyl alcohol resin can be saponified (page 3, [0024]). The Examiner equates the saponification of the polyvinyl alcohol fibers to Applicant's "modification of polyvinyl alcohol".

As to claim 3, Takeuchi teaches in Example 1 that 10g/m<sup>2</sup> of polyvinyl alcohol resin was applied to the fibrous base sheet (page 4, [0034]).

As to claims 5 – 8, Takeuchi teaches that the fibrous sheet and binder are water-soluble at cold temperatures (Abstract) such as at 10 degrees Celsius (page 4, [0029]).

As to claim 9, Takeuchi teaches that the polyvinyl alcohol resin can be completely saponified (page 3, [0024]) which meets Applicant's requirements of being saponified to at least 95%.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Jennifer Boyd*

Jennifer Boyd  
November 13, 2003

*Elizabeth M. Cole*  
ELIZABETH M. COLE  
PRIMARY EXAMINER